UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,674	12/31/2001	John Erven Jenne	H052617.1130US0	9034

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EXAMINER
PITARO, RYAN F

ART UNIT	PAPER NUMBER
2174	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/038,674	JENNE ET AL.
	Examiner	Art Unit	
	Ryan F. Pitaro	2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *June 10, 2005*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4, 9-21, 27-30, 33 and 34* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4, 9-21, 27-30, and 33-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
  Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-4, 9-21, 27-30, and 33-34 have been examined.

Response to Amendment

2.   This communication is responsive to Amendment B, filed June 10, 2005.

3.   Claims 1-4, 9-21, 27-30, and 33-34 are pending in this application. Claims

1, 11, and 33 are independent claims. In the Amendment B, Claims 1 and 11

were amended, and Claims 31-32 were canceled.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 1,2,4,27,33 are rejected under 35 U.S.C. 102(e) as being

anticipated by Hamano et al ("Hamano", US 2002/0166127).

As per independent claim 1, Hamano discloses a method of displaying a

commercial message on a display device of a computer during a user waiting

time, the method comprising: selecting the commercial message from a non-

volatile memory ([0032] lines 8-11); and displaying the selected commercial

message on the display device during the user waiting time, wherein the user

waiting: time includes waiting time associated with at least one of the computer

entering sleep mode, a virus scan, and a disk scan ([0035] lines 1-9,15-19).

As per claim 2, which is dependent on claim 1 Hamano discloses a

method wherein the commercial message comprises an advertisement message

([0029] lines 1-3).

As per claim 4, which is dependent on claim 1, Hamano discloses a

method wherein the step of selecting the commercial message further comprises

the steps of: tracking internet information associated with the computer ([0034]

lines 1-6); and choosing the commercial message to download to the non-volatile

memory from a website based on the internet information ([0034] lines 6-12).

As per claim 27, which is dependent on claim 1, Hamano discloses a

method further comprising: tracking user preferences; and downloading

additional commercial messages to the non-volatile memory that are tailored to

the user's interests based on the tracked user preferences ([0034] lines 6-12).

As per independent claim 33, Hamano discloses As per claim 33, Hamano

teaches a system to display commercial messages, comprising: a display device;

a basic input/output system (BIOS) routine executable to display a first

commercial message on the display device during a boot-up period ([0030] lines

1-6); an operating system ([0035] lines 9-11); and an application executable,

after loading and execution of the operating system, to display a second

commercial message on the display device during a user wait period ([0035]

lines 11-16) wherein the user wait period includes a wait period associated with

at least one of the system the system exiting sleep mode, a virus scan, a file download, and a disk scan ([0035] lines 1-9,15-19).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 9,10,17,18,19,28,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamano et al ("Hamano", US 2002/0166127) in view of Petrecca et al ("Petrecca", US# 5781894).

As per claim 9, which is dependent on claim 1, Hamano fails to disclose displaying a message according to a weight. However, Petrecca teaches a method wherein the commercial message is displayed for a duration according to a time weight assigned to the commercial. (Column 1 lines 64-67). Therefore it would have been obvious to an artisan at the time of the invention to combine the method of Hamano with the current teaching of Petrecca. Motivation to do so would have been to provide the user with a message, which would not cause an extended waiting time by waiting for the commercial message to finish.

As per claim 10, which is dependent on claim 1, Hamano fails to disclose displaying a message according to a frequency weight. However, Petrecca

teaches a method wherein the commercial message is repeated according to a

frequency weight assigned to the commercial message (Column 3 lines 14-17).

Therefore it would have been obvious to an artisan at the time of the invention to

combine the method of Hamano with the current teaching of Petrecca. Motivation

to do so would have been to provide the user with a variety of messages to

prevent the loss of interest.

As per claim 17, which is dependent on claim 11, Hamano fails to

distinctly point out disabling the commercial message. However, Petrecca

teaches a system wherein displaying the commercial message in the memory is

selectively disabled (column 4 lines 51-52). Therefore it would have been

obvious to an artisan at the time of the invention to combine the method of

Hamano with the current teaching of Petrecca. Motivation to do so would have

been to provide the user with an opportunity to rid of the commercial messages.

As per claim 18, which is dependent on claim 11 Hamano-Petrecca

teaches a system wherein deletion the commercial message in the memory is

selectively enabled (Petrecca, Column 4 lines 52-53).

As per claim 19, which is dependent on claim 11, Hamano-Petrecca

teaches a system wherein display of the commercial message is selectively

disable (Petrecca, Column 4 lines 48-53).

As per claim 28, which is dependent on claim 1, Hamano fails to distinctly

point out an alternate type of user wherein the user has an option to disable the

messages. However, Petrecca teaches determining whether the user is a

premium user (Column 3 lines 49-55); in response to determining that the user is

a premium user, providing an option to the user to disable display of the

commercial message (Column 3 lines 49-51). Therefore it would have been

obvious to an artisan at the time of the invention to combine the method of

Hamano with the current teaching of Petrecca. Motivation to do so would have

been to provide the user with an opportunity to rid of the commercial messages

while other non-premium users lack the option.

   As per claim 30, which is dependent on claim 10, Hamano discloses a

method further comprising assigning the frequency weight to the commercial

message based on a revenue generating capacity of the commercial message

([0036] lines 1-5).

8.   Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Hamano et al ("Hamano", US 2002/0166127) in view of Kreynin et al ("Kreynin",

US# 6067570).

   As per claim 3, which is dependent on claim 1, Hamano fails to disclose a

message, which includes productivity enhancement tips. However, Kreynin

teaches a method wherein the commercial message comprises productivity

enhancement tips for the computer (Column 8 lines 56-65). Therefore, it would

have been obvious to an artisan at the time of the invention to combine

Hamano's method with Kreynin's teaching. Motivation to do so would have been

to benefit from the updating of standard screens that are presented to the PC

operator during times of waiting (Column 8 lines 56-60).

9.   Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Hamano et al ("Hamano", US 2002/0166127) in view of Buch et al ("Buch", US#

6463468).

As per claim 29, which is dependent on claim 1, Hamano fails to distinctly

point out providing a password to enable updating of advertisements. However,

Buch teaches a method further comprising providing a password to enable

secure updating of the non-volatile memory with a password (Column 12 lines

42-51; wherein a password is used to authenticate user by the servers, Column 7

lines 56-61). Therefore, it would have been obvious to an artisan at the time of

the invention to combine Hamano's method with Buch's teaching. Motivation to

do so would have been to prevent any non-certified or tampered advertisements

from being downloaded to the user computer.

10.   Claims 11-16,20,21,34 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Hamano et al ("Hamano", US 2002/0166127) in view of Rao et

al.

As per independent claim 11, Hamano discloses a computer system for

displaying a commercial message comprising: a display device (Figure 4 item

411); a processor coupled to the display device (Figure 4 item 401); and a

memory coupled to the processor and containing code adapted to display the

commercial message on the display device ([0046] lines 3-8) during a user

waiting time, wherein the user waiting time includes waiting time associated with

at least one of the computer system entering sleep mode, a virus scan, and a disk scan ([0035] lines 1-9,15-19). Hanna fails to distinctly point out displaying a message based on its revenue generating capacity. However, Rao teaches further adapting memory to store a frequency weight to determine frequency of displaying the commercial message, the frequency weight having a value assigned according to a revenue generating capacity of the commercial message ([0026] lines 1-19). Therefore it would have been obvious to an artisan at the time of the invention to combine the teaching of Rao with the system of Hamano. Motivation to do so would have been to maximize revenue for any given advertising period.

As per claim 12, which is dependent on claim 11, Hamano-Rao discloses a system wherein the memory comprises a flash read-only memory (ROM) ([0047] lines 4-8).

As per claim 13, which is dependent on claim 11, Hamano-Rao discloses a system wherein the memory comprises a hard drive ([0020] lines 1-5; *personal computers including hard drives*).

As per claim 14, which is dependent on claim 11, Hamano-Rao discloses a system wherein the memory is updated with the commercial message from the Internet when the computer is connected to a website ([0034] lines 1-3).

As per claim 15, which is dependent on claim 11, Hamano-Rao discloses a system wherein the code comprises Basic Input/Output System (BIOS) code ([0030] lines 1-6).

As per claim 16, which is dependent on claim 11, Hamano-Rao discloses

a system wherein the code comprises a commercial messaging application

([0030] lines 1-6).

As per claim 20 which is dependent on claim 11, Hamano-Rao discloses s

a system wherein the commercial message is selectively saved for future display

on the display device ([0034] lines 9-12).

As per claim 21, which is dependent on claim 11, Hamano-Rao discloses

a system wherein the type of commercial message is user selectable ([0052]

lines 6-10).

Claim 34 is similar in scope to that of claim 11 and is therefore rejected

under similar rationale.

Response to Arguments

11.   Applicant's arguments filed 6/10/2005 have been fully considered but they

are not persuasive.

Applicant argues that Hamano fails to teach displaying a selected

commercial message on a display device during a user waiting time, where the

user waiting time includes waiting time associated with at least one of the

computer entering sleep mode, a virus scan, and a disk scan. The Examiner

disagrees for at least the reasons cited above. Hamano does in fact teach

displaying a commercial message during a virus scan. Hamano explains, "When

a remote display terminal is powered up, a number of programs or subroutines

are executed to initialize, load, and execute background functions necessary or

helpful to the terminals operation." He then goes on to further give examples of these types of programs. "Other programs may be a printer initialization sequence or a virus scan." Therefore Hamano does in fact include a virus scan as a user waiting time.

Applicant argues that there is no motivation to include the teachings of Petrecca in the system of Hamano. The Examiner disagrees. Petrecca teaches a system, which enables sponsors to present advertisements or commercials to a user during periods of waiting-time, which are inherent in normal computer use. Petrecca allows for the disabling of advertising messages during the inherent waiting times mentioned above, incase a user does not wish to view messages during the waiting times. Initialization of software is very similar to the booting up process as taught in Hamano. Therefore, it would be very obvious for a user to implement the teaching of Petrecca into the system of Hamano.

Applicant's arguments with respect to the rest of the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan F Pitaro whose telephone number is 571-272-4071. The examiner can normally be reached on 7:00am - 4:30pm Monday through Thursday, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 571-272-4063. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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